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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,931	11/16/2005	Jose Manuel Bartolome-Nebreda	PRD2059USPCT	5571
45511 7590 10/22/2007 WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891			EXAMINER MABRY, JOHN	
			ART UNIT 4133	PAPER NUMBER
			NOTIFICATION DATE 10/22/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@woodcock.com

Office Action Summary

Application No.

10/556,931

Applicant(s)

BARTOLOME-NEBREDA ET AL.

Examiner

John Mabry

Art Unit

4133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant is advised that claims 9-13 are "Use" claims. Please see MPEP 2173.05(q) for information on "use" claims. "Use" claims pending at the time of the first action on the merits will be rejected and, accordingly, withdrawn from examination. For restriction purposes, the Examiner has interpreted the "use" claims as method claims.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

- I. Claims 1, 3-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-N=CH-CH=CH-$ and Z^1-Z^2 = $-O-CH_2-O-$. A further election of single disclosed species is required.

Art Unit: 4133

- II. Claims 1, 3-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-N=CH-CH=CH-$ and Z^1-Z^2 = $-O-CH_2-CH_2-O-$. A further election of single disclosed species is required.
- III. Claims 1, 3-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-N=CH-CH=CH-$ and Z^1-Z^2 = $-NR^7-CH_2-CH_2-O-$. A further election of single disclosed species is required.
- IV. Claims 1, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-N=CH-CH=CH-$ and Z^1-Z^2 = $-O-CH_2-CH_2-NR^7-$. A further election of single disclosed species is required.
- V. Claims 1, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-N=CH-CH=CH-$ and Z^1-Z^2 = $-NR^7-CH_2-CH_2-NR^7-$. A further election of single disclosed species is required.
- VI. Claims 1, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-N=CH-CH=CH-$ and Z^1-Z^2 = $-S-CH_2-CH_2-O-$. A further election of single disclosed species is required.

Art Unit: 4133

- VII. Claims 1, 3-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and Z^1-Z^2 = $-\text{O}-\text{CH}_2-\text{O}-$. A further election of single disclosed species is required.
- VIII. Claims 1, 3-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and Z^1-Z^2 = $-\text{O}-\text{CH}_2-\text{CH}_2-\text{O}-$. A further election of single disclosed species is required.
- IX. Claims 1, 3-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and Z^1-Z^2 = $-\text{NR}^7-\text{CH}_2-\text{CH}_2-\text{O}-$. A further election of single disclosed species is required.
- X. Claims 1, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and Z^1-Z^2 = $-\text{O}-\text{CH}_2-\text{CH}_2-\text{NR}^7-$. A further election of single disclosed species is required.
- XI. Claims 1, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and Z^1-Z^2 = $-\text{NR}^7-\text{CH}_2-\text{CH}_2-\text{NR}^7-$. A further election of single disclosed species is required.

Art Unit: 4133

- XII. Claims 1, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4- = -CH=N-CH=CH-$ and $Z^1-Z^2 = -S-CH_2-CH_2-O-$. A further election of single disclosed species is required.
- XIII. Claims 1-8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-N=CH-$ and $Z^1-Z^2 = -O-CH_2-CH_2-O-$. A further election of single disclosed species is required.
- XIV. Claims 1-8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-N=CH-$ and $Z^1-Z^2 = -O-CH_2-CH_2-O-$. A further election of single disclosed species is required.
- XV. Claims 1-8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-N=CH-$ and $Z^1-Z^2 = -NR^7-CH_2-CH_2-O-$. A further election of single disclosed species is required.
- XVI. Claims 1-2, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-N=CH-$ and $Z^1-Z^2 = -O-CH_2-CH_2-NR^7-$. A further election of single disclosed species is required.

Art Unit: 4133

- XVII. Claims 1-2, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-N=CH-$ and $Z^1-Z^2 = -NR^7-CH_2-CH_2-NR^7-$. A further election of single disclosed species is required.
- XVIII. Claims 1-2, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-N=CH-$ and $Z^1-Z^2 = -S-CH_2-CH_2-O-$. A further election of single disclosed species is required.
- XIX. Claims 1-8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-CH=N-$ and $Z^1-Z^2 = -O-CH_2-O-$. A further election of single disclosed species is required.
- XX. Claims 1-8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-CH=N-$ and $Z^1-Z^2 = -O-CH_2-CH_2-O-$. A further election of single disclosed species is required.
- XXI. Claims 1-8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-CH=N-$ and $Z^1-Z^2 = -NR^7-CH_2-CH_2-O-$. A further election of single disclosed species is required.

Art Unit: 4133

XXII. Claims 1-2, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-\text{CH}=\text{CH}-\text{CH}=\text{N}-$ and Z^1-Z^2 = $-\text{O}-\text{CH}_2-\text{CH}_2-\text{NR}^7-$. A further election of single disclosed species is required.

XXIII. Claims 1-2, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-\text{CH}=\text{CH}-\text{CH}=\text{N}-$ and Z^1-Z^2 = $-\text{NR}^7-\text{CH}_2-\text{CH}_2-\text{NR}^7-$. A further election of single disclosed species is required.

XXIV. Claims 1-2, 4-5, 7 and 8 are drawn to compounds and compositions of Formula I, wherein $-a^1=a^2-a^3=a^4-$ = $-\text{CH}=\text{CH}-\text{CH}=\text{N}-$ and Z^1-Z^2 = $-\text{S}-\text{CH}_2-\text{CH}_2-\text{O}-$. A further election of single disclosed species is required.

XXV. Claims 9-13 are drawn to a method of prevention and/or treatment of a disease or disorder responsive to inhibition of Dopamine D_2 , D_3 , and/or D_4 , inhibition of serotonin uptake and antagonism of 5-HT_{1A} receptors, affective disorders such as general anxiety disorder, panic disorder, obsessive compulsive disorder, depression, social phobia and eating disorders; and other psychiatric disorders, a disease or disorder responsive to the combined effect of Dopamine D_2 , D_3 , and/or D_4 antagonist, an SSRI and a 5-HT_{1A} antagonist, and schizophrenia limited to the scope of one the compound groups I-XXIV. An election of species is required if this group is chosen. This group ^{maybe} is subject to further restriction.

Art Unit: 4133

XXVI. Claim 14 is drawn to a process of preparation of compounds of Formula I. An election of species is required if this group is chosen. This group ^{maybe} is subject to further restriction.

Note: For restriction purposes, the Examiner will interpret the "use" claims (claims 9-13) of Groups XXV as method claims.

The inventions listed as Groups I-XXVI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features...those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

The special technical feature corresponding to Group I is an indole structure wherein $-a^1=a^2-a^3=a^4-$ = $-N=CH-CH=CH-$ and Z^1-Z^2 = $-O-CH_2-O-$. Group II contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4-$ = $-N=CH-CH=CH-$ and Z^1-Z^2 = $-O-CH_2-CH_2-O-$. Group III contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4-$ = $-N=CH-CH=CH-$ and Z^1-Z^2 = $-NR^7-CH_2-CH_2-O-$. Group IV contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4-$ = $-N=CH-CH=CH-$ and Z^1-Z^2 = $-O-CH_2-CH_2-NR^7-$. Group V contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4-$ = -

Art Unit: 4133

$\text{N}=\text{CH}-\text{CH}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{NR}^7-\text{CH}_2-\text{CH}_2-\text{NR}^7-$. Group VI contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{N}=\text{CH}-\text{CH}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{S}-\text{CH}_2-\text{CH}_2-\text{O}-$. Group VII contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{O}-\text{CH}_2-\text{O}-$. Group VIII contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{O}-\text{CH}_2-\text{CH}_2-\text{O}-$. Group IX contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{NR}^7-\text{CH}_2-\text{CH}_2-\text{O}-$. Group X contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{O}-\text{CH}_2-\text{CH}_2-\text{NR}^7-$. Group XI contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{NR}^7-\text{CH}_2-\text{CH}_2-\text{NR}^7-$. Group XII contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{N}-\text{CH}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{S}-\text{CH}_2-\text{CH}_2-\text{O}-$. Group XIII contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{CH}-\text{N}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{O}-\text{CH}_2-\text{O}-$. Group XIV contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{CH}-\text{N}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{O}-\text{CH}_2-\text{CH}_2-\text{O}-$. Group XV contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{CH}-\text{N}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{NR}^7-\text{CH}_2-\text{CH}_2-\text{O}-$. Group XVI contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{CH}-\text{N}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{O}-\text{CH}_2-\text{CH}_2-\text{NR}^7-$. Group XVII contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{CH}-\text{N}=\text{CH}-$ and $\text{Z}^1-\text{Z}^2 = -\text{NR}^7-\text{CH}_2-\text{CH}_2-\text{NR}^7-$. Group XVIII contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -\text{CH}=\text{CH}-\text{N}=\text{CH}-$ and

Art Unit: 4133

$Z^1-Z^2 = -S-CH_2-CH_2-O-$. Group XIX contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-CH=N-$ and $Z^1-Z^2 = -O-CH_2-O-$. Group XX contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-CH=N-$ and $Z^1-Z^2 = -O-CH_2-CH_2-O-$. Group XXI contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-CH=N-$ and $Z^1-Z^2 = -NR^7-CH_2-CH_2-O-$. Group XXII contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-CH=N-$ and $Z^1-Z^2 = -O-CH_2-CH_2-NR^7-$. Group XXIII contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-CH=N-$ and $Z^1-Z^2 = -NR^7-CH_2-CH_2-NR^7-$. Group XXIV contains an indole structure as its special technical feature, wherein $-a^1=a^2-a^3=a^4- = -CH=CH-CH=N-$ and $Z^1-Z^2 = -S-CH_2-CH_2-O-$. The ring systems are not considered equivalent.

The technical feature corresponding to the methods claims of Groups XXVI is: a method of prevention and/or treatment of a disease or disorder responsive to inhibition of Dopamine D_2 , D_3 , and/or D_4 , inhibition of serotonin uptake and antagonism of $5-HT_{1A}$ receptors, affective disorders such as general anxiety disorder, panic disorder, obsessive compulsive disorder, depression, social phobia and eating disorders; and other psychiatric disorders, a disease or disorder responsive to the combined effect of Dopamine D_2 , D_3 , and/or D_4 antagonist, an SSRI and a $5-HT_{1A}$ antagonist, and schizophrenia limited to the scope of one the compound groups I-XXIV. There is a significant difference in the between compounds/compositions and method of treating/preventing diseases/conditions and methods of inhibition individually or in

Art Unit: 4133

combination. These treatments of diseases/conditions and compounds/compositions are not considered equivalent.

The special technical feature of Group XXVI is a process of preparing compounds of Formula I.

The special technical feature of this invention is the common core found in Formula 1. This special technical feature, found in WO 02/085911 A1 as described by Tran et al (compounds of Formula I, in abstract and page 2) – already of record (IDS).

Therefore the above claims, are not so linked as to form a single general inventive concept and there is a lack of unity of invention because they lack a common core structure and the technical features present fail to define a contribution over the prior art. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper.

Therefore, since the claims do not relate to a single general inventive concept under PCT Rule 13.1 and lack the same or corresponding special technical features, the claims lack unity of invention and should be limited to only one invention.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after

Art Unit: 4133

the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the

record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Rejoinder Advisory

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result**

in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Effective November 1, 2007, if applicant wishes to present more than 5 independent claims or more than 25 total claims in an application, applicant will be required to file an examination support document (ESD) in compliance with 37 CFR 1.265 before the first Office action on the merits (hereafter "5/25 claim threshold"). See Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications, 72 Fed. Reg. 46715 (Aug. 21, 2007), 1322 Off. Gaz. Pat. Office 76 (Sept. 11, 2007) (final rule). The changes to 37 CFR 1.75(b) apply to any pending applications in which a first Office action on the merits (FAOM) has not been mailed before November 1, 2007. Withdrawn claims will not be taken into account in determining whether an application exceeds the 5/25 claim threshold. For more information on the final rule, please see <http://www.uspto.gov/web/offices/pac/dapp/opla/presentation/clmcontfinalrule.html>.

In response to the restriction requirement set forth in this Office action, applicant is required to file an election responsive to the restriction requirement. Applicant may not file a suggested restriction requirement (SRR) in lieu of an election responsive to the restriction requirement as a reply. A SRR alone will not be considered a *bona-fide* reply to this Office action.

If applicant elects an invention that is drawn to no more than 5 independent claims and no more than 25 total claims, applicant will not be required to file an ESD in compliance with 37 CFR 1.265 that covers each of the elected claims. If the elected

Art Unit: 4133

invention is drawn to more than 5 independent claims or more than 25 total claims, applicant may file an amendment canceling a number of elected claims so that the elected invention would be drawn to no more than 5 independent claims and no more than 25 total claims.

If the restriction requirement is mailed on or after November 1, 2007, applicant is also required to file an ESD in compliance with 37 CFR 1.265 that covers each of the elected claims, unless the elected invention is drawn to no more than 5 independent claims and no more than 25 total claims taking into account any amendment to the claims. To avoid the abandonment of the application, the ESD (if required) and the election must be filed within **TWO MONTHS** from the mailing date of this Office action. The two-month time period for reply is extendable under 37 CFR 1.136.

If the restriction requirement is mailed before November 1, 2007, the election must be filed within **ONE MONTH** or THIRTY DAYS, whichever is longer, from the mailing date of this Office action. The time period for reply is extendable under 37 CFR 1.136. Furthermore, if the elected invention is drawn to more than 5 independent claims or more than 25 total claims taking into account any amendment to the claims, the Office will notify applicant and provide a time period in which applicant is required to file an ESD in compliance with 37 CFR 1.265 covering each of the elected claims or amend the application to contain no more than 5 independent elected claims and no more than 25 total elected claims.

Art Unit: 4133

Conclusion

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Mabry, PhD whose telephone number is (571) 270-1967. The examiner can normally be reached on M-F from 9am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker, can be reached on (571) 272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



JM



10/16/07
RITA DESAI
PRIMARY EXAMINER